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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,649	02/28/2006	Yoshimitsu Kagiwada	SHIO-0110	4613
23377 7590 02/05/2009 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER PLUCINSKI, JAMESUE A				
ART UNIT 3629		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,649

**Applicant(s)**

KAGIWADA ET AL.

**Examiner**

JAMISUE A. PLUCINSKI

**Art Unit**

3629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tozzoli et al. (6,151,588) in view of Business Wire (Article: Retail Decision and I4 Commerce Form Alliance to Provide the Bill Me Later Payment Option for LiveProcessor Users).
4. With respect to Claim 1: Tozzoli discloses the use of a parcel delivery information exchange system (The system of Tozzoli is one that processes payments and stored billings amounts for items purchased and delivered, therefore the examiner considers the system to be fully capable of retrieving transaction state of the commodity by the parties involved in the commodity transaction, and the examiner considers the system of Tizzoli fully capable of

mutually exchanging the transaction state of the commodity on a network, the system comprising:

- a. Commodity information storage means (Column 6, lines 48-52 and Claim 7);
- b. Door-to-Door parcel delivery information storage means, that stores a billing amount and delivery state information of the commodity (Column 8, lines 14 to 23);  
(with respect to the limitation of "said delivery state information including a moving state of being in the vicinity of an intersection and in the vicinity of a building", this limitation is considered to be intended use of the storage means. The claims are directed towards a system, which are held to the structural limitations and the capabilities thereof. The claim discloses the use of a storage means, therefore what information it is storing is considered to be non-functional and does not effect the structure of the storage means, and therefore the storage means of Tozzoli is fully capable of storing the delivery state information);
- c. Communications means (Reference numeral 40);
- d. Processing means that controls the operation of each means (20A... 20N), wherein the processing means receives the order reception information from a receiver side terminal (See Figure 2A, Column 6, lines 35-47), stores a billing amount based on the order (Column 7, lines 1-8 and Column 8, lines 15-22, the orders are associated with a price, therefore when the purchase order is accepted and stored, the examiner considers this to be the billing amount that is stored), receives and stores delivery state information from the deliverer side terminal (Column 8, lines 6-13), receives and transmits a billing amount to orderer, seller and the buyers broker (Column 9, lines 15-23). Tozzoli

discloses that the order can come with a payment guarantee, therefore the system of Tozzoli is fully capable of having the commodity shipped before payment is confirmed.

5. With respect to the phrase "wherein said processing means receives information that a payment in accordance with the billing amount is completed to avoid suffering a loss due to duplicate payments at payment on delivery": As stated above, the claims are directed towards a system, which is held to the structural limitations and the capabilities thereof. The processing means of Tozzoli is fully capable of receiving payment information, storing payment information and keeping track of whether a payment has been received, therefore fully capable of receiving information that a payment in according with the billing amount has been received.

6. Tozzoli discloses the order can come with a payment guarantee, however fails to specifically disclose an order receiver then ships the commodity to a user of the receiver side terminal before confirming payment with the receiver side terminal. The Business Wire article discloses the use of catalog and website order receivers using an option of "Bill Me Later" which is a method of shipping a product to the customer before payment is received (See Page 1). The examiner considers this to be the order receiver shipping the commodity to a user of the receiver side terminal before confirming payment with the receiver side terminal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tozzoli to include the "Bill Me Later" feature as described in the Business Wire article, in order to eliminating the need for a credit card at purchase and enables merchants to reduce transaction costs (See Business Wire article, Page 1)

7. With respect to Claim 2: Tozzoli discloses the use of shipping document templates, which the examiner considers to be a form of a shipping slip. Figure 3A discloses the system to

store templates, use deliverer information and prepare the shipping documents and forward them to the seller to finalize the terms (See Figure 3A, Reference numerals 610, 620, 630 and 850 with corresponding detailed description).

8. With respect to Claims 3 and 5: See Figure 3C with corresponding detailed description.

9. With respect to Claim 6: See Reference numerals 640 and 870 with corresponding detailed description.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozzoli et al. and Business Wire in view of Kadaba (6,539,360).

11. Tozzoli and The Business Wire article, disclose the use of shipping orders, however fails to disclose the items of the order are fragile articles or pets, and fails to disclose the delivery status is a state of the article or the pet. Kadaba discloses the use of a special handling item shipping and tracking system, which ships and tracks whether a package designated for special handling (such as fragile items, Column 6, lines 1-8) has been applied to the packages (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Tozzoli and Business Wire to include the tracking of special handling items, such as in Kadaba in order to provide a system which applies special handling to fragile items at appropriate times and to determine if there is a reoccurring failure in the special handling of items. (See Kadaba Column 4).

***Response to Arguments***

12. Applicant's arguments filed 10/30/08 have been fully considered but they are not persuasive.

13. The applicant has added many new limitations into the claim, as intended use of the system. As stated above, the claims are directed towards a system. A system claim is in essence an apparatus claim and is held to the structural limitations as well as the capabilities thereof. The limitations added to the claims, do not state that the structure is configured to or programmed to perform the functions, and use the specific data in a particular way in order to make it functional. Therefore in a system claim, the newly added claim limitations are considered to be intended use.

14. The applicant has added into the pre-amble, the term "capable of simultaneously grasping the transaction state of the commodity by the parties involved in the commodity transaction", this is simply a term of what the system is capable of doing. The system of Tozzoli communicates with both parties, therefore fully capable of performing this task.

15. The applicant has added "by mutually exchanging the transaction state of the commodity on a network", again this is a system claim, and not a method of exchanging information, therefore the method step is not positively claimed, and therefore considered to be intended use of the system.

16. The applicant has added "said delivery state information including a moving state of being in the vicinity of an intersection and in the vicinity of a building", this phrase is again descriptive of the information the storage means stores, however does not functionally affect the system, therefore considered to be non-functional descriptive material and related to intended use

of the system. The system is the same regardless of what type of delivery state information it is storing.

17. The applicant has added “wherein said processing means receives information that a payment in accordance with the billing amount is completed to avoid suffering a loss due to duplicate payments at payment on delivery”, again the processing means is fully capable of receiving information on whether an amount has been paid, due to the fact that the processing means of Tozzoli processes payments. Furthermore, it is common on delivery slips to have a section for Amount Paid and Amount Owed. And when using the Bill Me Later option, then the system would not collect payment on delivery and therefore would avoid suffering a loss due to duplicate payments.

18. Applicant arguments are not considered to be persuasive, therefore rejections stand as stated above.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629